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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,878	10/31/2001	Juha Rasanen	975.375USW1	5211

32294 7590 10/19/2004

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EXAMINER

GESESSE, TILAHUN

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/036,878

Applicant(s)

JUHA RASANEN

Examiner

Tilahun B Gesesse

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5 &amp; 7</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 34-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim (US 6,349,224) in view of Wang et al "Wang"(US 6230,024).

Claims 34,41-47,50, Lim discloses a method for establishing a connection in a telecommunication network (figures 5-6) comprising

Lim discloses different protocols (TCP/IP/PPP), and an inter-working function (MSC, IWF (2-13 and 50 of figure 3) for adapting the different protocol features used for a connection between the calling terminal and inter-working function and the inter-working function and the called party (column 1, line 65-column 2,line 55), comprising:  
Lim discloses receiving at the inter-working function from a terminal a request to establish a connection of a first type using data "first protocol features" (column 2, lines 20-35).

Lim discloses performing a setup processing according to the first protocol features used for the first type of connection between the inter-working and the called party (column 2, lines 20-55, column 3, lines 23-40).

Lim discloses determining a second type of connection; establishing the second type of connection between the inter-working function and the called terminal and changing the connection between the terminal and the inter-working function to the second type of connection (column 3, lines 33-38) and second type of connection between IWF and called terminal (figure 3).

Lim does not expressly teach checking the result of the setup processing and indicates the set up processes not successful. However, Wang teaches communication signal 202 is transmit between BS 114 and MS 104 the an indication that service option is et equal to voice a short indication the service supports only voice protocol (column 3, lines 64-67 and network initiate service negotiation to set up the digital fax transmission, the parameters of the call being changed from voice to digital fax (column 4, lines 7-19). to illustrate, checking the result of set up process not successful, the call from voice to digital fax is changed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to check the set up process, as taught by Wang, for switching the different protocol in order to connect the communication by inter-working function.

Claim 35,53, Lim discloses a monitoring operation performed in a network element arranged between the calling party and said called party (figure 3, calling part 11 and called party PSDN or PSTN).

Claims 36-38,54-55, Lim does not teach a connection fallback from the first type of connection to the second type of connection is performed in the network element. However, Wang teach the parameter of the call for being changed from voice to digital fax, "fallback" to the voice connection "first type" (column 4, lines 12-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to change from first protocol to second protocol, as taught by Wang, in order to adapt parameters change due to called party parameter changes.

Claims 39, 57Lim does not disclose a multimedia connection. However, Wang teaches a multimedia connection i.e., voice and data and fax, column 3, line 63-column 4, lines 1-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize multimedia connection, as taught by Wang, since multimedia is advantageous than single media communication for the user.

Claims 40,58,Lim discloses the second type of connection is a speech connection (column 5, lines 27-42).

Claim 48, 65, Lim does not discloses to determine the second type of connection on the basis of a predetermined priority. However, Wang teaches the digital fax "second type" connection has priority than other connections (column 4, lines 9-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to set connection priority based on the negotiation between the IWF and called party.

Claims 49,51, Lim and Wang do not specifically teach the ITU\_T recommendation H-324 and HSCSD call to the called party. However, it is notoriously

well known in the art to establish such connection. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize ITU-T and HSCSD interface multimedia connection.

Claim 52, 56,59-64,Lim discloses a system for establishing a connection in a telecommunication network (figures 5-6) comprising

Lim discloses different protocols (TCP/IP/PPP), and an inter-working function (MSC, IWF (2-13 and 50 of figure 3) for adapting the different protocol features used for a connection between the calling terminal and inter-working function and the inter-working function and the called party (column 1, line 65-column 2,line 55), comprising: Lim discloses receiving at the inter-working function from a terminal a request to establish a connection of a first type using data "first protocol features" (column 2, lines 20-35).

Lim discloses performing a setup processing according to the first protocol features used for the first type of connection between the inter-working and the called party (column 2, lines 20-55, column 3, lines 23-40).

Lim discloses determining a second type of connection; establishing the second type of connection between the inter-working function and the called terminal and changing the connection between the terminal and the inter-working function to the second type of connection (column 3, lines 33-38) and second type of connection between IWF and called terminal (figure 3).

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### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee et al (6,490,291) disclose plurality of terminals interfacing inter-working unit (IWU) and Internet and circuit switching terminal (figure 8).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Tilahun Gesesse*  
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**TILAHUN GESESSE**  
**PATENT EXAMINER**

October 12, 2004